REMARKS

Claims 7 and 11-13 are all the claims pending in the application.

Claim 7 has been amended to delete one member of a Markush group defining R^1 and to delete the upper range of integers for j. Accordingly, no new matter is added.

1. Claims 7, 12, and 13 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Rogers et al. (WO 0031032, IDS 02/23/2005), in view of Chen et al. (IDS 12/22/2004).

The Examiner asserted that Rogers et al. teaches pyrrolidine derivative-CCR-3 receptor antagonists with a general formula I, where Z may be N, A may be -NCO-, B is alkylene with 1-4 carbon atoms inclusive wherein one of the carbon atoms may optionally be replaced by -N(R4)-, Ar^1 and Ar^2 may be aromatic or heteroaromatic rings, including a naphthyl group, which allegedly meet all the limitations of the claimed compounds except that n is defined as 1, and the claimed compounds allow n to be 0. The Examiner further asserted that the reference compounds are disclosed as useful pharmaceutical agents for treating CCR-3 receptor associated disorders, particularly, eosinophil-mediated inflammatory diseases.

The Examiner recognized that Rogers et al. does not teach expressly the employment of the presently claimed compound for treating the eosinophilic disorders.

However, the Examiner concluded that it would have been prima facie obvious to a person of ordinary skill in the art, at the time the claimed invention was made, to use the claimed compounds as CCR-3 receptor antagonists for treating the eosinophilic disorders because the

instant compounds are allegedly structural homologs of the reference compounds. The Examiner asserted that one having ordinary skill in the art would have been motivated to prepare the instantly claimed compounds because such structurally homologous compounds are expected to possess similar properties. The Examiner stated that it has been held that compounds that are structurally homologous to prior art compounds are prima facie obvious, absent a showing of unexpected results. In re Hass, 60 USPQ 544 (CCPA 1944); In re Henze, 85 USPQ 261 (CCPA 1950).

2. Claim 11 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Rogers et al. (WO 0031032, IDS 02/23/2005), for reasons as set forth above, and in further view of Chen et al. (IDS 12/22/2004).

The Examiner recognized that Rogers et al. does not teach expressly the employment of CCR-3 receptor antagonists for treating AIDS.

However, the Examiner asserted that Chen et al. teaches that CCR-3 is a co-receptor for HIV-1 infection of microglia and that the receptor promotes efficient infection by HIV in CNS.

The Examiner concluded that, therefore, it would have been prima facie obvious to a person of ordinary skill in the art, at the time the claimed invention was made, to use the claimed CCR-3 receptor antagonists for treating AIDS patients.

The Examiner asserted that a person of ordinary skill in the art would have been motivated to use the CCR-3 receptor antagonists for treating AIDS patients because a CCR-3 antagonist would have been reasonably expected to slow the infection by HIV in CNS.

The Examiner further stated that Applicant's amendments and remarks submitted May 25, 2006 were not persuasive. According to the Examiner, Applicant's position was premised solely on the fact that Rogers et al. did not prepare any compounds that fall within the amended claims. The Examiner stated that disclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or non-preferred embodiments. The Examiner cited In re Susi, 169 U.S.P.Q. 423 (CCPA) in support of this position.

For the following reasons, the rejections are overcome.

The Examiner has cited outdated law. In re Susi was decided by the CCPA, and has not been followed by the Federal Circuit.

The law in this area is sparse, but clear. Most importantly, it starts from the premise that structural similarity is a question of fact and that if a genus is sufficiently large, not all compounds encompassed by a genus are necessarily suggested by the genus. Thus, in In re Jones, 21 U.S.P.Q.2D (BNA) 1941 (Fed. Cir. 1992), the court found that a claimed dicamba salt was not suggested by a reference that disclosed a "potentially infinite genus" of salts of dicamba and listed several such salts, but did not specifically disclose the claimed salt. More specifically, the claimed salt was the 2-(2'-aminoethoxy)ethanol salt of dicamba. The court compared the structure of the closest specifically disclosed dicamba salts with the structure of the claimed salt. The court characterized the claimed salt as a primary amine with an ether linkage.

One of the closest disclosed salts was a diethanolamino salt, which differed from the claimed salt in that the reference salt was a secondary amine without an ether linkage. Further, the court found it relevant that the closest disclosed ammonium salt of dicamba having an ether

linkage was a morpholino salt, which has a cyclic structure, whereas the claimed salt had a linear structure. Finally, the court pointed out that while the reference disclosed an isopropylamino salt that was a primary amine, the iso structure of the claimed salt was quite different.

Similarly, in In re Baird, 29 U.S.P.Q.2D (BNA) 1550 (Fed. Cir. 1994), the court found that bisphenol A was not taught or suggested by disclosure of a genus of diphenols covered by a generic formula. The court estimated that the generic formula encompassed more than 100 million different diphenols, only one of which was bisphenol A. The court further found that the reference appeared to teach away from bisphenol A by focusing on more complex diphenols, which was clear from the specific compounds disclosed and from the description of the preferred and optimum embodiments, as well as the diphenols used in the working examples.

Turning to the present claims, due to the amendments to claim 7, the compound of present claim 7 differs from the preferred compounds of Rogers et al. (described in col. 15 - col. 21) in 4 aspects. First, the substituents R^1, G, and j in amended claim 7 differ from Ar1 (corresponding to R^1 in the amended claim 7), B (corresponding to G), and Q (corresponding to j) of the preferred compound of Rogers et al., respectively. Second, Rogers et al. does not describe the compound of the formula (I) of the present invention wherein when k is 1 and m is 2, then n is 0. Thus, Applicant submits, respectfully, that under the current law as applied by the Federal Circuit, the presently claimed compounds are not made obvious over the cited references. Accordingly, the Examiner is requested to reconsider and remove the rejections.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the

Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

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